

## REMARKS

Claims 12-30 were previously pending. Claims 1-11 were previously canceled without prejudice to the ability to seek consideration of the non-elected claims in a further application. No additional claims have been canceled or added. Applicants request reconsideration of pending claims 12-30 in light of the above amendments and the following remarks.

### **§102 Rejections**

**Claims 12, 13, 20, 22, and 24-30** stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,045,579 to Hochshuler et al. (“Hochshuler”).

The PTO provides in MPEP § 2131 that

*"[t]o anticipate a claim, the reference must teach every element of the claim...."*

Therefore, to sustain the rejection of these claims Hochshuler must teach all of the claimed elements of each claim.

With respect to independent claim 12, Hochshuler at least fails to teach, “laterally inserting a first insertion member into the first vertebra such that the first insertion member does not extend within the intervertebral space,” and “laterally inserting a second insertion member into the second vertebra.” As the Examiner stated, “Hochshuler does not explicitly disclose inserting the upper and lower vertebral members laterally into the vertebrae.” Office Action, page 4. Further, the devices of Hochshuler are configured for placement within the intervertebral space and, therefore, extend within the intervertebral space contrary to the requirements of claim 12. Thus, for at least these reasons Hochshuler fails to teach all of the claimed elements of independent claim 12. Claims 13 and 20 depend from and further limit claim 12. Thus, for at least these reasons Applicants request that the §102 rejection of claims 12, 13, and 20 over Hochshuler be withdrawn.

With respect to independent claim 22, Hochshuler at least fails to teach, “engaging a first member with a sidewall of the first vertebra.” The devices of Hochshuler are configured for placement within the intervertebral space between adjacent vertebrae and engage the endplates of the vertebrae. See e.g., Figs. 4A, 4B, 16, and 21. The devices of Hochshuler simply are not

configured to engage the sidewall of the vertebrae. Thus, one skilled in the art would not engage the devices of Hochshuler with a sidewall of a vertebra as required. Therefore, for at least this reason Hochshuler fails to teach all of the claimed elements of independent claim 22. Claims 24-30 depend from and further limit claim 22. Thus, for at least these reasons Applicants request that the §102 rejection of claims 22 and 24-30 over Hochshuler be withdrawn.

**Claims 22 and 24-30** stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,665,122 to Kambin (“Kambin”). With respect to independent claim 22, Kambin at least fails to teach, “engaging a first member with a sidewall of the first vertebra.” Similar to Hochshuler, the devices of Kambin are configured for placement within the intervertebral space between adjacent vertebrae and engage the endplates of the vertebrae. See e.g., Figs. 1, 2, and 4. The devices of Kambin simply are not configured to engage the sidewall of the vertebrae. Thus, one skilled in the art would not engage the devices of Kambin with a sidewall of a vertebra as required. Therefore, for at least this reason Kambin fails to teach all of the claimed elements of independent claim 22. Claims 24-30 depend from and further limit claim 22. Thus, for at least these reasons Applicants request that the §102 rejection of claims 22 and 24-30 over Kambin be withdrawn.

**Claims 22, 23, 28, and 30** stand rejected under 35 U.S.C. § 102(a) as being anticipated by EP 1222900 to Nohara et al. (“Nohara”). With respect to independent claim 22, Nohara at least fails to teach, “rotating the connecting member to move the first vertebra and the second vertebra relative to one another to reduce the spondylolisthesis therebetween.” Nohara simply does not disclose rotating the rod member 1 “to move the first vertebra and the second vertebra relative to one another to reduce the spondylolisthesis therebetween” as recited. Nohara discloses axially moving the rod member 1 and rotating the rod member with the same tool prior to integrally fixing the rod member to the screws 5. Col. 3, Lines 2-29. In that regard, the rod member may be rotated so that the curve of the rod member corresponds to the curve of the backbone. Nohara simply does not disclose rotating the rod member 1 to adjust the positions of the vertebrae. Thus, for at least this reason Nohara fails to disclose all of the claimed elements of independent claim 22. Claims 23, 28, and 30 depend from and further limit claim 22. Thus, for

at least these reasons Applicants request that the §102 rejection of claims 22, 23, 28, and 30 over Nohara be withdrawn.

### **§103 Rejections**

**Claims 12, 13, 20-22, and 24-30** stand rejected, in the alternative, under 35 U.S.C. § 103(a) as being obvious over Hochshuler

The PTO provides in MPEP §2131 that

“The examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness. If the examiner does not produce a prima facie case, the applicant is under no obligation to submit evidence of nonobviousness.”

The Examiner clearly cannot, using Hochshuler, establish a prima facie case of obviousness in connection to claims 12, 13, 20-22, and 24-30 for at least the following reasons.

35 U.S.C. §103(a) provides, in part, that:

“A patent may not be obtained . . . if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time of the invention was made to a person having ordinary skill in the art . . .”  
(emphasis added)

Thus, when evaluating a claim for determining obviousness, all limitations of the claim must be evaluated. However, Hochshuler at least fails to disclose “laterally inserting a first insertion member into the first vertebra such that the first insertion member does not extend within the intervertebral space” and “laterally inserting a second insertion member into the second vertebra” as recited in claim 12. In particular, it would not have been obvious to one skilled in the art to laterally insert a device of Hochshuler such that the device does not extend within the intervertebral space because the devices are configured for placement within the intervertebral space. Further, as discussed above Hochshuler at least fails to disclose “engaging a first member with a sidewall of the first vertebra,” as recited in claim 22. Claims 13, 21, 22, and 24-30 depend from and further limit claims 12 and 22. Thus, for at least these reasons the §103 rejection of claims 12, 13, 20-22, and 24-30 over Hochshuler cannot be supported and Applicants request that it be withdrawn.

**Claims 12-16** stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent Application Publication No. 2004/0138749 to Zucherman et al. (“Zucherman”) in view of U.S. Patent No. 5,314,477 to Marnay (“Marnay”). However, even when combined Zucherman and Marnay fail to disclose “laterally inserting a first insertion member into the first vertebra such that the first insertion member does not extend within the intervertebral space” and “laterally inserting a second insertion member into the second vertebra” as recited in claim 12. In particular, the devices of both Zucherman and Marnay are configured for use within the intervertebral space. Thus, it would not have been obvious to one skilled in the art to laterally insert a device of Zucherman or Marnay such that the device does not extend within the intervertebral space as required by claim 12. Thus, for at least this reason the §103 rejection of claims 12-16 over Zucherman and Marnay cannot be supported and Applicants request that the rejection be withdrawn.

**Claims 12 and 17** stand rejected under 35 U.S.C. §103(a) as being unpatentable over Nohara in view of U.S. Patent No. 5,545,164 to Howland (“Howland”). However, even when combined Nohara and Howland fail to teach, “applying a rotating force to the connecting member to rotate the first and second vertebrae relative to one another.” Nohara discloses axially moving the rod member 1 and rotating the rod member with the same tool prior to integrally fixing the rod member to the screws 5. Col. 3, Lines 2-29. In that regard, the rod member may be rotated so that the curve of the rod member corresponds to the curve of the backbone. Nohara simply does not disclose applying a rotating force to the rod member 1 “to rotate the first second vertebrae relative to one another.” Howland does not affect this deficiency. Thus, even when combined Nohara and Howland fail to disclose all of the claimed elements of independent claim 12. Claim 17 depends from and further limits claim 12. Thus, the §103 rejection of claims 12 and 17 over Nohara and Howland cannot be supported and Applicants request that the rejection be withdrawn.


**Claims 18 and 19** stand rejected under 35 U.S.C. §103(a) as being unpatentable over Nohara in view Howland—as applied to claim 17—further in view of U.S. Patent No. 6,030,389 to Wagner (“Wagner”). However, as shown above even when combined Nohara and Howland fail to disclose all of the claimed elements of independent claim 12 and, therefore, dependent

claim 17. Wagner does not affect this deficiency. Thus, for at least the same reasons the §103 rejection of claims 18 and 19 over Nohara, Howland, and Wagner cannot be supported and Applicants request that rejection be withdrawn.

### CONCLUSION

It is believed that all matters set forth in the Office Action have been addressed and that all pending claims are in condition for allowance. Accordingly, Applicants request an early indication of allowance of the pending claims. Should the Examiner have any questions, please contact the undersigned at the number below.

Respectfully submitted,

  
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